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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/849,968	05/08/2001	Nariie Kaneko	2001_0571A	1298
513	7590	07/23/2004	EXAMINER	
WENDEROTH, LIND & PONACK, L.L.P.			PATTERSON, MARIE D	
2033 K STREET N. W.			ART UNIT	
SUITE 800			PAPER NUMBER	
WASHINGTON, DC 20006-1021			3728	

DATE MAILED: 07/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/849,968

Applicant(s)

KANEKO, NARIE

Examiner

Marie Patterson

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 11-33 is/are pending in the application.
- 4a) Of the above claim(s) 32 and 33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

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1. ***Election/Restrictions***
2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 11-31, drawn to a pair of shoes, classified in class 36, subclass 127.
  - II. Claims 32 and 33, drawn to a method of performing a golf swing, classified in class 473, subclass 270.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions of Group I and Group II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)).

In the instant case the product can be used to correct foot/ambulatory abnormalities for walking and other activities when the user is not a golfer or golfing.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
5. Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.

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6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

7. Newly submitted claims 32 and 33 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: see above restriction.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 32 and 33 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 11-14, 17-21, 24-28, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller, II (6550160) in view of either O'Brien (3218734), Wellman (4875683), or Chiroff (4407079).

Miller, II shows a pair of shoes with a sealed bag (22) located on the outside portion (lateral portion under the small toe) of the sole, a hand pump 48), and release valve (20) substantially as claimed except for the bag being located in

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the forward portion of the sole. Miller, II is silent as to the longitudinal location of the bag. O'Brien, Wellman, or Chiroff teaches that the location for medial/lateral augmenting devices for golfing should be located only in the forward portion of the shoe sole. It would have been obvious to locate the angling device only in the forward portion as taught by either O'Brien, Wellman, or Chiroff in the pair of shoes of Miller, II to provide proper, secure angling of the foot for golfing.

In reference to claims 18-31, the phrases "for a right-handed golfer..." and "for a left-handed golfer...", these phrases have been treated as intended use recitations and the shoes disclosed are clearly capable of being used as stated in the claims. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.

3. Claims 15, 16, 22, 23, 29, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 11-14, 17-21, 24-28, and 31 above, and further in view of either Goldston (5588227) or Cohen (5113599).

Miller, II as modified above shows a pair of shoes substantially as claimed except for the hand pump and release valve being located on the tongue. Goldston or Cohen teaches placing hand pumps and valves on tongues of footwear. It would have been obvious to place the pump and valve on the tongue as taught by either Goldston or Cohen in the shoes of Miller, II as modified above to make the pump easier to access.

***Response to Arguments***

4. Applicant's arguments filed 5/20/04 have been fully considered but they are not persuasive.

In response to applicants' arguments that the bladder of Miller, II is located in the heel, there is no clear basis for such an allegation. The cross sections relied upon by applicant could also be cross sections in the forefoot portion anterior to the laces, i.e. towards the toe portion of the shoe or it could be a cross sectional view at a location in between eyelets. There is no clear basis in Miller, II as to the longitudinal location of the bladder in the specification or the drawings.

In response to applicants' arguments that the bladder of Miller, II needs to be located in the rear portion in order to function to slant the shoe to one side when swinging a golf club, this is clearly not persuasive or true since the modifying references all teach and show the use of devices only in the forefoot area to do exactly the same function. The modifying references (O'Brien, Wellman, or Chiroff) clearly teach that the obvious (if not inherently known in the art of golfing footwear) location of the augmenting device should only be placed in the forefoot area of the footwear to provide proper weight distribution of the wearer during a golf swing. Since the prior art specifically teaches such, the device of Miller, II as modified by such references would not only function as intended but would obviously be the location intended to be disclosed by Miller, II. The modified device would clearly not be inoperable.

In response to applicants' arguments directed towards the intended use of the pair of shoes, i.e. the specific user, it has been held that a recitation with respect

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to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.

### ***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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1. Telephone inquiries regarding the status of application or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the Examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148 or the **Tech Center 3700 Customer Service Center number is (703) 306-5648**. For applicant's convenience, the Group Technological Center FAX number is (703) 872-9306. (Note that the Examiner **cannot** confirm receipt of faxes) Please identify Examiner \_\_\_\_\_ of Art Unit \_\_\_\_\_ at the top of your cover sheet of any correspondence submitted.

Inquiries only concerning the **merits** of the examination should be directed to Marie Patterson whose telephone number is (703) 308-0069.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g. copies of references cited, form PTO-1449, for PTO-892, etc. requests for copies of such papers should be directed to (703) 308-1337.

Check out our web-site at "www.uspto.gov" for fees and other useful information.



Marie Patterson  
Primary Examiner  
Art Unit 3728